

REMARKS

**I. Status of the Claims**

Upon entry of this response, claims 36, 51-52 and 61 will be pending. Claims 45-48, 50 and 70 have been withdrawn from consideration. However, to the extent that claims 45-48, 50, and 70 are dependent on an allowable claim, Applicants respectfully request such claims be allowed as well. All other claims have been cancelled without waiver, prejudice or disclaimer. Claim 36 is drawn to a method of making an attenuated FIV-141 virus. Claims to the attenuated FIV-141 virus itself were recently allowed by the Examiner in the parent application no. 09/378,810. Claim 36 has been amended to be consistent with the allowed virus claim. Claims 51 and 52 have been amended to further clarify Applicants' claimed invention. Support for the amendment to claims 36, 51 and 52 can be found in the claims as originally filed as well as on page 6, lines 32-33; page 8, lines 4-8 of the Specification. No new matter has been added by the present amendment.

**II. First Rejection Under 35 U.S.C. § 112, second paragraph**

Claims 36 and 52 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because the term "significantly reduced infectivity" is a relative term which renders the claim indefinite. This rejection has been rendered moot by the amendment to claims 36 and 52 in Applicants' last response as well as in the current response to recite "...significantly reduced infectivity to feline T lymphocytes relative to the wild type FIV-141 virus..." Applicants respectfully request this rejection be withdrawn.

**III. Second Rejection Under 35 U.S.C. § 112, second paragraph**

Claim 36 stands rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection has been rendered moot by the amendment of claim 36 to recite "...mutating by deletion in an ENV gene of the wild-type virus." Applicants respectfully request this rejection be withdrawn.

**IV. First Rejection Under 35 U.S.C. § 112, first paragraph**

Claims 36, 51-52 and 61 stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the invention was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection.

As set forth in MPEP 2163:

The first paragraph of 35 U.S.C. 112 requires that the 'specification shall contain a written description of the invention \*\*\*.' This requirement is separate and distinct from the enablement requirement.

...  
To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.

Here, Applicants clearly had possession of the claimed invention. The original specification, claims and sequence listing adequately describe Applicants' claimed invention including all recited elements. Written description support can be found on, among others, page 6, line 27 through page 8, line 19. Applicants respectfully request this rejection be withdrawn.

**V. Second Rejection Under 35 U.S.C. § 112, first paragraph**

Claims 36, 51-52 and 61 stand rejected under 35 U.S.C. § 112, first paragraph in view of the written description rejection as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection has been rendered moot by amendment to the claims to recite mutation by deletion in the ENV gene. Applicants respectfully request this rejection be withdrawn.

**VI. Third Rejection Under 35 U.S.C. § 112, first paragraph**

Claims 36, 51-52 and 61 stand rejected under 35 U.S.C. § 112, first paragraph, as based on disclosure which is not enabling because the claims refer to a specific FIV-141 which the specification indicates has been deposited but the deposit rules have not been met. Applicants respectfully disagree. As evidenced by the two ATCC attachments, viral strain FIV-141 (ATCC VR-2619) and plasmid pFIV-141-B1 (ATCC 203001) were both deposited under the Budapest Treaty on July 1, 1998 and fully complies with MPEP 2402. Applicants respectfully request this rejection be withdrawn.

**VII. Conclusion**

Applicants respectfully request reconsideration of the subject application in view of the above remarks. The subject application is now in condition for allowance and early notice to that effect is respectfully solicited.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 16-1445. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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